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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 27

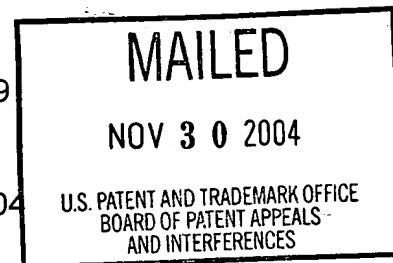
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte** PETER J. KIGHT, MARK A. JOHNSON,  
TAMARA K. CHRISTENSON, REGINA LACH,  
PHILIP POINTER, and KENNETH COOK

Appeal No. 2004-1783  
Application No. 09/542,109

HEARD : November 17, 2004



Before KRASS, DIXON, and NAPPI, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 36, 38-40, 42-44, 46-48, 50-56, and 58-61, which are all of the claims pending in this application.

We REVERSE and REMAND.

## BACKGROUND

Appellants' invention relates to a bill payment system and method utilizing bank routing numbers, but the claimed invention is limited to a method and system for verifying the bank routing numbers and a determination that the financial institution has electronic funds transfer capability. An understanding of the invention can be derived from a reading of exemplary claim 36, which is reproduced below.

36. A method for processing consumer banking information, comprising:

storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file;

receiving a routing number associated with a financial institution at which a consumer maintains a deposit account; and

comparing the received routing number to the stored plurality of routing numbers in the financial institutions file to verify accuracy of the received routing number.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Case	4,270,042	May 26, 1981
Braun et al. (Braun)	4,321,672	Mar. 23, 1982
Lawlor et al. (Lawlor)	5,220,501	Jun. 15, 1993

Paschal, "New Edition of Rand McNally Bankers Directory Available,"  
Journal Record, Oklahoma City, Oklahoma, pp. 1-3, Feb. 11, 1987 (reprinted from the  
Internet at [proquest.umi.com](http://proquest.umi.com); printout dated Jan. 27, 2003)

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Claims 36, 38 and 39 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braun in view of Pascal. Claim 40 stands rejected under 35 U.S.C. § 103 as being unpatentable over Braun and Pascal in view of Lawlor and Case. Claims 42, 43, 44, 46-48, 50, 51, 52-56, and 58-61 stand rejected under 35 U.S.C. § 103 as being unpatentable over Braun and Pascal in view of Lawlor and Case.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's final rejection (Paper No. 11, mailed Feb. 28, 2003) and the examiner's answer (Paper No. 20, mailed Nov. 19, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 19, filed Aug. 29, 2003) and appellants' reply brief (Paper No. 22, filed Jan. 20, 2004) for the appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

**35 U.S.C. § 101**

At the outset, we note the examiner had issued a rejection of claims 36, 38, 39, 40 and 42 under 35 U.S.C. § 101 in the final rejection under 35 U.S.C. § 101. Appellants responded to the rejection in the first request for reconsideration and the examiner indicated in an Advisory Action that the rejection under 35 U.S.C. § 101 was withdrawn without further comment. (See final rejection at page 6 and the Advisory Action dated June 3, 2003 at page 2.) When we read appellants' specification, we find that appellants disclose a computer implemented method and system. When asked at the oral hearing, what makes independent claim 36 a statutory process, appellants' representative, responded that the method provides a "concrete and tangible" result which is a verified routing number. When asked how this process is different from a bank teller in the 1950's looking up, in the Rand McNally publication of the Pascal reference (a book published since 1911), a bank routing number that is on a draft/check that is received at a financial institution to determine if the check is drawn on a valid institution, appellants' representative indicated that the method is intended to cover a computer implemented system and that the Pascal reference does not disclose how the book is used. We agree with appellants' that the disclosed (not the claimed) invention appears to be directed to a computer implemented invention, and we find that the specification is replete with alternatives which "may" be used so as to make no specific representation that the system must be a computer implemented method, and

we find that the invention as claimed is not required to be a computer implemented process. Furthermore, we find no limitation which would require more than looking up a bank routing number that is on a draft/check that is received at a financial institution or the federal reserve in a book or on a list to determine if the check is drawn on a valid or invalid institution. Rather than to institute a new grounds of rejection under 37 CFR 41.50 of claims 36, 38, 39, 40 and 42 under 35 U.S.C. § 101, we remand the case to the examiner to reevaluate why he withdrew the rejection under 35 U.S.C. § 101 and to provide a clear indication on the record of why those claims that were rejected were found to be directed to statutory subject matter.

### **35 U.S.C. § 103**

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available

to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory

statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 36.

Appellants argue throughout the brief, reply brief and at oral hearing that the examiner has not established a *prima facie* case of obviousness of the claimed invention. Specifically, appellants argue that the examiner has not shown in the applied prior art a teaching or suggestion of verifying a bank routing number against a plurality of stored bank routing numbers. We agree with appellants. From our review of the disclosure of Braun, we agree with appellants that Braun appears to be only concerned with the singular financial institution and the verification of its bank routing number(s).<sup>1</sup> From our review of the brief disclosure of Pascal, we agree with appellants

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<sup>1</sup> Here, we question whether multiple merged banks with their own distinct routing numbers into a larger financial entity would be within the teachings of Braun so

that Pascal merely is a directory of active and retired, and we find no teaching or suggestion in either Braun or Pascal to combine this static directory into the system of Braun to expand the functionality of Braun to provide an additional comparison of each bank routing number presented to the financial institution to a file containing a plurality of bank routing numbers. While we could speculate as to the need in a large financial institution, with a plurality of subsidiary banks and/or financial institutions, to centralize this functionality for all of its subsidiary banks and/or financial institutions, we have no teaching before us that would fairly suggest such an extension of the teachings of Braun. To find otherwise would require us to resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. Therefore, we find that the examiner has not established a **prima facie** case of obviousness of the invention as recited in independent claim 36 and its dependent claims.

With respect to independent claim 42 (and dependent claim 40), the examiner adds the teachings of Lawlor and Case to further evidence to obviousness of the invention as claimed. The examiner maintains that Lawlor teaches and suggests a

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that a bank checks the bank routing numbers against all its subsidiary banks to verify that it is one of its plurality of subsidiary banks. Yet, we are unclear as to whether these banks which are merged are then not financial institutions within the scope of the disclosed and claimed invention. We do not find that appellants' specification clarifies what is a financial institution and if it would cease to be a financial institution and become a financial entity.



determination of whether an Electronic Funds Transfer (EFT) is accepted by the consumer's financial institution based on the verified routing number. (Answer at page 17.) Appellants argue that Lawlor teaches that a consumer's financial institution always uses electronic transfers and that the use of the non-electronic transfers (paper checks) is from the financial institution to the merchant and no determination is performed and if performed is not based on the verified routing number. (Brief at pages 15-17 and reply brief at page 7.) We agree with appellants and find no determination based on the verified routing number. Similarly, the examiner maintains that the teachings of Case in the combination teaches the determination of whether an EFT is accepted by the consumer's financial institution base on the verified routing number. (Answer at pages 13-14.) Appellants argue that Case does not teach a determination of whether an EFT is accepted by the consumer's financial institution base on the verified routing number and that there is merely a selection by the consumer. (Brief at pages 16-17 and reply brief at pages 7-9.) We agree with appellants and find no teaching in either Case or Lawlor that expressly teaches or fairly suggests a determination of whether an EFT is accepted by the consumer's financial institution based on the verified routing number. Therefore, additionally we find that the examiner has not made a **prima facie** case of obviousness of the invention as claimed in independent claim 42 and dependent claim 40.

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Moreover, we find that independent claims 43, 44, 50, 51, 52, 58, 59 and 60 all contain similar limitations which were lacking in the allied prior art combinations.

Therefore, we cannot sustain the rejections of claims 43, 44, 50, 51, 52, 58, 59 and 60 and their dependent claims.

### CONCLUSION

To summarize, the decision of the examiner to reject claims 36, 38-40, 42-44, 46-48, 50-56, and 58-61 under 35 U.S.C. § 103 is reversed. Additionally, we remand this application to the examiner to reconsider the rejection under 35 U.S.C. § 101 or clarify the record as to the reason why the rejected claims were found to be statutory.

### REVERSED and REMANDED

  
ERROL A. KRASS  
Administrative Patent Judge

  
JOSEPH L. DIXON  
Administrative Patent Judge

  
ROBERT E. NAPPI  
Administrative Patent Judge

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